Office Action Summary	Application No.	Applicant(s)	
	10/043,991	BROWN ET AL.	
	Examiner	Art Unit	
	OJO O. OYEBISI	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2002*.

2a)☐ This action is FINAL. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 May 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/27/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10043984. Although the conflicting claims are not identical, they are not patentably distinct from each other because the referenced copending application and the instant application are claiming common subject matter, as follows: Claim 1 of the instant application recites "A method of transferring wealth, comprising: causing a transferor to transfer cash to a transferee as a loan; causing said transferee to purchase an insurance policy for a cost, said policy having a term portion, at least a portion of said cost being a cost of said term portion; valuing said term portion at an economic benefit, said economic benefit being greater than said cost of said term portion; causing said transferee to assign said term portion to said transferor for a period, said period being sufficiently large to accrue sufficient economic benefit to retire said loan," and claim 1 of the copending application recites substantially the same limitations as claim 1 of the instant application except for claim 1 of the copending application, recites "A method of transferring wealth, comprising: causing a transferor to obtain a debt of a transferee, thereby acquiring a note from said transferee." Claims 2-13 of the instant application recites substantially the same limitations as claim 2-13 of the copending application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-13 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea. The examiner notes that the disclosed invention is within the technological arts. The claimed invention does not include a series of steps to be performed by a computer. The claimed invention also is not a product for performing a process, not it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction. Claims 1-13 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompasses any product of the class configured in any manner to perform the underlying process. **The claimed invention of claims 1-13 also does not include a post-computer process activity or pre-computer process activity. Thus, no physical transformation is performed.** Thus, claims 1-13 are analyzed based upon the underlying process, and are rejected as being directed to non-statutory process.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with informalities too numerous to mention specifically. The following noted informalities are merely exemplary thereof. The claims should be revised to confirm to U.S Patent Office practice.

Re claims 1, 6, 11 and 12, the claims are vague and indefinite because "said policy having a term portion " recited, renders the claims unclear. What exactly is a "term portion"?

Re claims 1, 6, 11 and 12, the claims are vague and indefinite because there is no proper antecedent basis for "at least a portion of said cost being a cost of said term portion." What are the costs?

Re claims 1, 6, 11 and 12, the claims are vague and indefinite because "valuing said term portion at an economic benefit" renders the claim unclear. How?

Re claims 1, 6, 11 and 12, the claims are vague and indefinite because the phrase "sufficiently" renders the claim(s) indefinite because the claim(s) include elements not actually disclosed (those encompassed by "sufficiently"), thereby rendering the scope of the claim (s) unascertainable.

Re claims 1, 6, 11 and 12, the claims are vague and indefinite because "said period being sufficiently large to accrue sufficient economic benefit" renders the claim unclear.

Re claims 2, 7 and 13, the claims are vague and indefinite because "IRS" and "Table PS58" render the claims unclear (acronym).

Re claims 4 and 9 claims are vague and indefinite because " reverting assignment" and "means for reverting assignment" renders the claims unclear. What does it mean by "reverting assignment"?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Burgess (US PAT: 5,966,693).

Re claims 1, 2, 4, 5, 7, 9, 10. Burgess further discloses a method of transferring wealth, comprising: causing a transferor to transfer cash to a transferee as a loan (i.e., it is an object of the invention to automate the selection of an optimized collection of related terms of a combined insurance, loan and employment arrangement, legally to avoid unnecessary taxation while permitting the transfer of value from an employer to an employee, see col.4 lines 20-25); causing said transferee to purchase an insurance policy for a cost, said policy having a term portion, at least a portion of said cost being a cost of said term portion (i.e., and to produce a leveraged split dollar insurance plan having a predetermined

term of years, with minimal tax exposure, and in compliance with present Internal Revenue rules, see col.4 lines 35-45); valuing said term portion at an economic benefit (see col.5 lines 32-45), said economic benefit being greater than said cost of said term portion; causing said transferee to assign said term portion to said transferor for a period (see col.4 lines 55-65), said period being sufficiently large to accrue sufficient economic benefit to retire said loan (see abstract, also see the summary of the invention).

Re claim 3. Burgess further discloses the method, further comprising: terminating said insurance policy after said loan has been retired (i.e., as the insurance policy appreciates in value, premiums decrease, the employee can pay down the loan and eventually eliminates premium payments, see the abstract).

Re claim 6. Burgess further discloses a system of transferring wealth, comprising: means for causing a transferor to transfer cash to a transferee as a loan (i.e., it is an object of the invention to automate the selection of an optimized collection of related terms of a combined insurance, loan and employment arrangement, legally to avoid unnecessary taxation while permitting the transfer of value from an employer to an employee, see col.4 lines 20-25, see fig.1a-1d); means for causing said transferee to purchase an insurance policy for a cost, said policy having a term portion, at least a portion of said cost being a cost of said term portion (i.e., and to produce a leveraged split dollar insurance plan having a predetermined term of years, with minimal tax exposure, and in

compliance with present Internal Revenue rules, see col.4 lines 35-45, see fig.1a-1d); means for valuing said term portion at an economic benefit(see col.5 lines 32-45, see fig.2 and 3), said economic benefit being greater than said cost of said term portion; means for causing said transferee to assign said term portion to said transferor for a period (see col.4 lines 55-65), said period being sufficiently large to accrue sufficient economic benefit to retire said loan.

Re claim 8. Burgess further discloses the system, further comprising: means for terminating said insurance policy after said loan has been retired (i.e., as the insurance policy appreciates in value, premiums decrease, the employee can pay down the loan and eventually eliminates premium payments, see the abstract, also see fig.1d).

Re claims 11-13. Burgess further discloses a program product, comprising machine readable program code for causing a machine to perform the following method steps: causing a transferor to transfer cash to a transferee as a loan (i.e., it is an object of the invention to automate the selection of an optimized collection of related terms of a combined insurance, loan and employment arrangement, legally to avoid unnecessary taxation while permitting the transfer of value from an employer to an employee, see col.4 lines 20-25); causing said transferee to purchase an insurance policy for a cost, said policy having a term portion, at least a portion of said cost being a cost of said term portion (i.e., and to produce a leveraged split dollar insurance plan having a predetermined term of years, with minimal tax exposure, and in compliance with present Internal

Revenue rules, see col.4 lines 35-45); valuing said term portion at an economic benefit, said economic benefit being greater than said cost of said term portion (see col.5 lines 32-45); causing said transferee to assign said term portion to said transferor for a period (see col.4 lines 55-65), said period being sufficiently large to accrue sufficient economic benefit to retire said loan (see abstract, also see the summary of the invention).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER